



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,906	04/21/2004	Joanna Hong Zhang	J6886(C)	5655

201 7590 07/10/2007  
UNILEVER INTELLECTUAL PROPERTY GROUP  
700 SYLVAN AVENUE,  
BLDG C2 SOUTH  
ENGLEWOOD CLIFFS, NJ 07632-3100

EXAMINER

FISHER, ABIGAIL L

ART UNIT	PAPER NUMBER
----------	--------------

1609

MAIL DATE	DELIVERY MODE
-----------	---------------

07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/828,906	ZHANG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Abigail Fisher	1609	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

### DETAILED ACTION

Claims 1-10 are pending

#### ***Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 4, and 6-8 are drawn to a composition comprising a terpenoid, classified in class 514, subclass 74.
  - II. Claims 1, 3-4, 6-8 and 9 are drawn to a composition consisting of fatty compounds, classified in class 514, subclass 538.

Inventions I and II are directed to related inventions. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the compounds would be structurally dissimilar, mutually exclusive, and are classified in separate subclasses based on their differing structures.

Therefore, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

### ***Election***

Applicant is required to elect a species from each of the following 3 species election requirements.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of compounds for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

#### **First Species Election Requirements**

If Applicant elects Group I then the Applicant is required to select either 1) Acyclic Terpenoid, 2) Cyclic Terpenoid, 3) Cycloaliphatic Compounds Structurally Related to Terpenes or 4) Sterols. Currently Claims 1, 4, and 6-8 are generic to Group I.

If Applicant selects Group II then the Applicant is required to select either 1) Fatty Acids, 2) Fatty Acid Salts, 3) Fatty Acid Glycerides, or 4) Fatty Alcohols. Currently Claims 1, 3-4, 6-8 and 9 are generic to Group II.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a**

Art Unit: 1609

claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

## **Second Species Election Requirements**

### **For Group I:**

If Applicant elects Group I and 1) Acyclic Terpenoids then the Applicant must also elect a specific type to be examined from the following list: Hydrocarbons, Alcohols, Aldehydes and Acetals, Ketones, Acids and Esters, or Nitrogen containing unsaturated Terpene derivatives.

If Applicant elects Group I and 2) Cyclic Terpenoids then the Applicant must also elect a specific type to be examined from the following list: Hydrocarbons, Alcohols and Ethers, Aldehydes and Ketones, and Esters.

If the Applicant elects Group I and 3) Cycloaliphatic Compounds Structurally Related to Terpenes then the Applicant must also elect a specific type to be examined from the following list: Alcohols, Aldehydes, Ketones, and Esters.

If the Applicant elects Group I and 4) Sterols then the Applicant must also select from the following list: betulin (betulinic acid and alcohol), cholesterol, sitosterol, ergosterol, stigmasterol, linosterol or none of the afore mentioned.

Claims 1, 4, and 6-8 are generic for Group I and 1) Acyclic Terpenoid, 2) Cyclic Terpenoid, 3) Cycloaliphatic Compounds Structurally Related to Terpenes or 4) Sterols.

### **For Group II:**

If Applicant elects Group II and 1) Fatty Acids then the Applicant must elect a specific fatty acid from the following list: oleic acid, linoleic acid, linolenic acid, ricinoleic

Art Unit: 1609

acid, elaidic acid, petroselenic acid, erucic acid, palmitoleic acid, myristoleic acid and 12-hydroxyoleic acid, conjugated linoleic acids or none of the afore mentioned.

If Applicant elects Group II and 1) Fatty Acids and conjugated linoleic acid then the Applicant must elect a specific conjugated linoleic acid in which the position of the double bond is clearly delineated as well as the particular configuration of the double bonds (cis or trans or a particular combination of cis and trans).

If Applicant elects Group II and 2) Fatty Acid Salts then the Applicant must elect a specific fatty acid salt from the following list: sodium oleate, potassium oleate, ammonium oleate, triethanolammonium oleate, sodium linolenate, potassium linolenate, ammonium linolenate, triethanolammonium linolenate or none of the afore mentioned.

If Applicant elects Group II and 3) Fatty Acid Glyceride then the Applicant must elect a specific glyceride from the following list: sunflowerseed oil, soybean oil, olive oil, cottonseed oil, groundnut oil, shea nut oil, palm oil, cocoa butter, illipe, borage and borage seed oil, coriander seed oil, linseed oil, triglycerides with conjugated linoleic acid, a particular mixture, or none of the afore mentioned.

If Applicant elects Group II and 3) Fatty Acids Glyceride and triglycerides with conjugated linoleic acid then the Applicant must elect a specific triglyceride and a specific conjugated linoleic acid in

Art Unit: 1609

which the position of the double bond is clearly delineated as well as the particular configuration of the double bonds (cis or trans or a particular combination of cis and trans).

If Applicant elects Group II and 4) Fatty Alcohols then the Applicant must elect a specific fatty alcohol from the following list: oleyl alcohol, linoleyl alcohol, linolenyl alcohol, a particular mixture, or none of the afore mentioned.

Claims 1, 3-4, 6-8 and 9 are generic for Group II and 1) Fatty Acids, 2) Fatty Acid Salts, 3) Fatty Acid Glycerides, or 4) Fatty Alcohols.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.**

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are



Art Unit: 1609

added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

### **Third Species Election Requirements**

Applicant is required to elect a single species with respect to substituted urea. Specifically each  $R_1$ ,  $R_2$ ,  $R_3$ , and  $R_4$  must be selected from the following group: hydrogen,  $C_{1-6}$  alkyl, and  $(R_5)_nOH$ . Where if  $(R_5)_nOH$  is chosen then  $R_5$  is clearly defined as either: methylene, ethylene, propylene or none of the former.

Claims 1, 3, and 5-6 are generic for substituted urea.

**A proper response would include four selections relating to a specific selection of  $R_1$ ,  $R_2$ ,  $R_3$ , and  $R_4$ .**

Art Unit: 1609

The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.**

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at

Art Unit: 1609

the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

Art Unit: 1609

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Art Unit: 1609

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail Fisher whose telephone number is 571-270-3502. The examiner can normally be reached on M-Th 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1609

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

\*\*\*



CECILIA TSANG

SENIOR ADVISORY PATENT EXAMINER